

REMARKS

Upon entry of the present amendments, claims 5, 10-15, 25, and 26 will be pending. Claims 8, 9, 23 and 24 have been canceled herein without prejudice or disclaimer. Claims 5, 7, 10, 11, 25, and 26 have been amended. The amendments are supported by the specification and original claims and, therefore, do not add new matter.

Rejection Under 35 U.S.C. § 102(b)

The rejection of claims 8 and 11-15 under 35 U.S.C. 102(b), as allegedly being anticipated by Goodearl et al. (June 1999) WO 99/28470, is respectfully traversed.

It is alleged that claims 8 and 11-15 are anticipated by Goodearl because the claims require only that the polynucleotide comprise at least 15 bases of and is capable of specifically hybridizing under highly stringent conditions to the nucleic acids of the Markush group and that the polynucleotide of Goodearl meets these limitations. Applicants respectfully traverse. While the Applicants maintain the traversal previously made of record and submit that Goodearl fails to disclose any 15 nucleotide sequences, the claims have been amended and are no longer drawn to a polynucleotide containing only 15 continuous bases, although Applicants expressly reserve the right to pursue this subject matter in a related application. In particular, claim 8 has been canceled and claim 11 has been amended to depend from claim 7. As such, the current amendments render the rejection moot.

Accordingly, for the reasons set forth above, withdrawal of the rejection of claims 8 and 11-15 under 35 U.S.C. § 102(b), as being anticipated by Goodearl et al. is respectfully requested.

Rejection Under 35 U.S.C. § 112

Applicants respectfully traverse the rejection of claims 5, 7-15, and 23-26 under 35 U.S.C. 112, first paragraph, as allegedly failing to comply with the written description requirement.

It is alleged in the Office action that the claimed polynucleotide sequences are defined in the claims using an indefinite article and, therefore, the structural limitations set forth in the claims would be present in many functionally divergent molecules. In particular, the polynucleotides of claims 7-15 and 23-26 are interpreted by the Examiner as broadly encompassing any nucleic acid encoding “a polypeptide having an amino acid sequence” or “having a nucleotide sequence” that can include any sequence set forth in the identified SEQ ID NO, including fragments of the identified SEQ ID NO’s of two or more amino acids/nucleotides in length. For example, with respect to claims 5 and 7, the Examiner has interpreted the phrase “having an amino acid sequence as set forth in SEQ ID NO:2” as broadly including any amino acid sequence set forth in SEQ ID NO:2, including any two or more amino acid sequence fragment of SEQ ID NO:2. As such, the Examiner alleges that the claims embrace polynucleotides having broadly divergent properties which are not adequately described in terms of structure and function.

Applicants respectfully traverse and submit that the Examiner’s interpretation of the claims is not reasonable in light of the disclosure in the specification or the claims viewed as a whole. In order to advance the prosecution of the present application, however, the claims have been amended in accordance with the Examiner’s suggestion. In particular, the claims have been amended to include the definite article “the” in referring to a sequence identified by a SEQ ID NO. For example, claim 5 has been amended to recite “having the amino acid sequence as set forth in SEQ ID NO:2”; claim 7 has been amended to recite “having the amino acid sequence as set forth in SEQ ID NO:2” and “having the nucleotide sequence as set forth in SEQ ID NO:1”; claim 10 has been amended to recite “having the nucleic acid sequence set forth in SEQ ID NO:5”; and claim 26 has been amended to recite “having the nucleotide sequence as

set forth in SEQ ID NO:3". Additionally, claims 8, 9, 23 and 24 have been canceled herein and claim 11 has been amended to depend from claim 7.

As such, the current claims are more clearly directed to polynucleotides comprising the entire sequence set forth in the respective SEQ ID NOs recited in the claims. Accordingly, withdrawal of the rejection of claims 5, 7-15, and 23-26 under 35 U.S.C. 112, first paragraph, is respectfully requested.

Rejection Under 35 U.S.C. § 102(e)

The rejection of claim 26 under 35 U.S.C. § 102(e) as allegedly being anticipated by Schlegel et al. (WO 01/60860) is respectfully traversed.

It is alleged that Schlegel discloses a nucleic acid comprising a sequence that is identical to nucleotides 1-4727 of the instant SEQ ID NO:3 and encodes the instant SEQ ID NO:4 (see also, Office communication mailed 4/28/2004). Applicants again point out, however, that according to the sequence alignment provided by the Examiner, the nucleic acid sequence of Schlegel contains bases that do not match SEQ ID NO:3 and that Schlegel does not disclose a complete sequence as set forth in SEQ ID NO:3. The Examiner's attention is respectfully drawn to page 5, second column of the sequence alignment provided by the Examiner in the Office communication mailed 4/28/2004, which illustrates mismatched bases at bases 1963 and 2071 of the query sequence (a copy of the sequence alignment marked to show the mismatched bases is submitted herein as Exhibit A). As such, Schlegel does not teach a polynucleotide having the nucleotide sequence as set forth in SEQ ID NO:3, as currently claimed.

It is further alleged in the Office action that the claim is not limited to a polynucleotide comprising the entire SEQ ID NO:3, but encompasses a polynucleotide comprising any portion of SEQ ID NO:3. As set forth above, however, claim 26 has been amended to recite "a polynucleotide having the nucleotide sequence as set forth in SEQ ID NO:3" and, therefore, is more clearly drawn to a polynucleotide comprising the full length SEQ ID NO:3.

The Examiner further alleges that the fragments of SEQ ID NO:3 encompassed by the claims are fully disclosed by Schlegel. Applicants point out, however, that while Schlegel

appears to teach a 4804 base nucleic acid sequence that is not identical to the current SEQ ID NO:3, Schlegel fails to teach polynucleotides limited to any particular segment of the prior art polynucleotide. More specifically, Schlegel does not teach a polynucleotide consisting of a polynucleotide as set forth in nucleic acid residues 1-331, 799-903, 1232-1543, 2147-2486, or 2964-4756 of SEQ ID NO:3, as required by the current claim 26. Applicants submit that these elements are missing from the teachings of Schlegel, thereby precluding a finding of anticipation.

It is further noted in the Office action that the rejection has not been set forth against claims directed to a polynucleotide encoding a polypeptide as set forth in SEQ ID NO:4 because the Examiner was unable to determine if such a polynucleotide was taught in the priority documents of Schlegel. A review of the priority documents of Schlegel by the Applicants similarly did not reveal any teachings as to a polynucleotide encoding a polypeptide as set forth in SEQ ID NO:4, as currently claimed. If the Examiner believes this to be in error, Applicants invite the Examiner to specifically point out where in the priority documents of Schlegel the claimed polynucleotide can be found. Applicants submit that the filing date of the current application and the support for the claimed invention is prior to the filing date of Schlegel.

In summary, for the reasons set forth above, it is submitted that the cited reference does not teach each and every element of the claimed invention. Accordingly, removal of the rejection of claim 26 under 35 U.S.C. § 102(e), as allegedly lacking novelty in light of Schlegel et al., is respectfully requested.

In re Application of:
Kumagai and Dunphy
Application No.: 09/982,091
Filed: October 17, 2001
Page 8

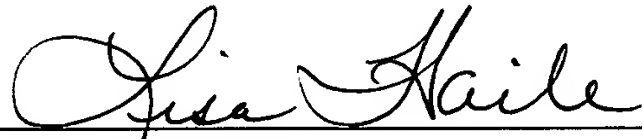
PATENT
Attorney Docket No.: CIT1320-1

In view of the above amendments and remarks, Applicants believe that all claims are now in condition for allowance, which action is respectfully requested. The Examiner is invited to contact Applicants' undersigned representative if there are any questions relating to this application.

Please charge any additional fees, or make any credits, to Deposit Account No. 07-1896.

Respectfully submitted,

Date: April 15, 2005



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Attachment: Exhibit A

Db 4549 CTCACAAAAAAGTGGGTCACCCAGGCTGAAGGCCAGGGAA 4608
QY 4561 CCTGAATGATAAGGGAAGGAACTTAGGCCACAGTCTGATTAGAAATGGGGCTCAATT 4620
Db 4609 CCTGAATGATAAGGGAAGGAACTTAGGCCACAGTCTGATTAGAAATGGGGCTCAATT 4668
QY 4621 CCACCCCTGTTTTCCTTACTGGAGATTCAATTGAATTACTCTGCTCCCTTCCTTATTC 4680
Db 4669 CCACCCCTGTTTTCCTTACTGGAGATTCAATTGAATTACTCTGCTCCCTTCCTTATTC 4728
QY 4681 CTTTCCCTTTTAAATAGTCATCATATCATATAAATTTCTTTTCC 4727
Db 4729 CTTTCCCTTTTAAATAGTCATCATATCATATAAATTTCTTTTCC 4775

RESULT 3
ABK52610
ID ABK52610 standard; DNA; 4754 BP.
ABK52610;
27-AUG-2002 (first entry)
DNA encoding Xenopus Claspin protein.
Chk1 protein; SQ/TQ motif; isoelectric point; cell cycle progression;
nuclear localisation signal; DNA replication checkpoint; benign neoplasm;
cell proliferative disorder; malignant neoplasm; frog; claspin; gene; ds.
Xenopus sp.
Key Location/Qualifiers
CDS 71..3928
/*tag= a
/product= "Xenopus Claspin protein"

WO200233115-A2.
25-APR-2002.
17-OCT-2001; 2001WO-US32316.
17-OCT-2000; 2000US-241246P.
(CALY) CALIFORNIA INST OF TECHNOLOGY.
Kumagai A, Dunphy WG;
WPI; 2002-452394/48.
P-PSDB; AAU97586.
Novel Claspin polypeptide specifically interacting with Chk1 protein
useful for identifying compound that modulates cell cycle progression
and for treating cell proliferative disorder like neoplasm -

Claim 7; Fig 1; 97pp; English.
The present invention relates to a new substantially pure Claspin
polypeptide that specifically interacts with a Chk1 protein, having SQ/TQ
motifs, an isoelectric point of 4.5 and at least one nuclear localisation
signal. The method of the invention is useful for identifying a compound
that modulates cell cycle progression and for modulating cell cycle
progression in a cell. The invention is useful for the proper operation
of DNA replication checkpoint in the cell cycle. The method is also
useful for treating a disorder associated with cell cycle progression
e.g. cell proliferative disorder such as benign or malignant neoplasm.
The molecules of the invention are also useful for detecting the altered
levels of claspin expression. The present nucleic acid sequence encodes
the Xenopus Claspin protein of the invention.

Sequence 4754 BP; 1658 A; 832 C; 1066 G; 1198 T; 0 other;
Query Match 15.4%; Score 730.2; DB 24; Length 4754;

Best Local Similarity 54.3%; Pred. No. 3e-111;
Matches 2085; Conservative 0; Mismatches 1523; Indels 231; Gaps 21;
QY 184 ATGAAACAAATTGGACCCCTTGAGTGAAGGAGATTCAGATGAAGAGATTTGTAAAGTAAGA 243
Db 186 ATAAATATTGGGTTGTGGAGGATAAAGATACAGATGATGAATCTTGGTTTCGTAAAA 245
QY 244 AGTTGAAACACAGGAAGGTTCTACAAAGACAGTGA---TTCCGAAACAGAGGACACAAATG 300
Db 246 AATCTAAACAAAGGAAGTATTGGTGGATAGTGACAGTGACGAAGATTTGGAATGGCTA 305
QY 301 CCTCTCCAGAGAAACTACCTATGACAGTCCCGAGGAGGAAATTAAGAGAAATTTATATG 360
Db 306 ATTTTGCAGATAATGTAAGGGGCACTCTGATATATGAGGAGAAATGAGGAGACTATGCTG 365
QY 361 CTGGGAAAAATACAAAAATCAAAAGGATTTCAAAAACTGTGGCAGACAGTATGAAAGTT 420
Db 366 CTTATAGAGA---AAACCAAGAAAGATCCGTTTCGCTGTATTGGACAGTGACAAATAGTG 422
QY 421 ACATGGAAAGTCTTTGTATCAGGAAATCTTGAAGCGCAAGTGAACCTTCTTGAAGCC 480
Db 423 ATCATGAGCTTGATGTTCAAAATAGTACAAGTCAAAATGCAGCTGAATACCTGAGTCAG 482
QY 481 TGAGTCTTCAGTCTGGAACCTCTACAGACTTTTACCAGTACAGAAAGAGTTCCTCAAAAGC 540
Db 483 AACATGATAGCTTGAGAGAGAACTCATACTGTGAAGCTTAAACAGCAAGTCTCTGA 542
QY 541 ACATACATGATAAGAAAGGAACCTGCAGGAAAGCAAGAAAGTAAATCAAAAGAAAGACTTG 600
Db 543 AAAAACAACTGACACTANTAAAGAGGAAATCGTGAAGAAATTAATCAAGCGCAAAATTC 602
QY 601 AGAAAGAGGAGAGAAATATGAAAGAAATTTAGACAGTAAAGAAAGAAAGAAACCAACC 660
Db 603 CGAAAGAGAGATTAAGAGAGGAGCAAAACAGAAAGTCAAAAGCA----- 646
QY 661 AGAAAGATGATGTAGAACAGCCATTAATGACAGTGGCTGTCTTCTTGTGGATAAGAGCC 720
Db 647 --GTTGCTGAAGCTAGGCCAAATTAATTAATGACAGTGGCTGCTTACTACAGATGGAGATC 704
QY 721 TTTTGAACCTGGTGGAGGATGAAGAAATAACTCTCCATTGGAAGATGAAGAGTCAATAG 780
Db 705 TTTTGAACATGGGTTGGAAATGAGATGAGATTCT---AATGAAGAGAGAGGATTTCTCTTG 761
QY 781 AATCAATAAGAGCAGCTGTAAACAAAGTAAACAAAGTAAACAAAGTAAACAAAGTAAACCTT 840
Db 762 AAGCTATCCGGCAAAATGAAGCAAACT-----GAATAGTCAATTTCTGCTG 809
QY 841 TGGAGAGTGGGTCCTCATTTGAGGAAGGAAGTCAAGTATATCAAGGAAGCAACCGAGGA 900
Db 810 AAAATTTGAGACACTTTGAACCTGATACCTGAAGGCAATCAAGAAATCCCGAGAAAGAA 869
QY 901 AGGAAAGAAAGCAGCCAGATTAAGTAAAGAGCAATTAACAAACAACTGATAGTGAAGCTC 960
Db 870 AGGAACGAAAGCTGCGGACCTTGTGAAGAGGCCATGAAGAAACAAATGACAGTGAACCC 929
QY 961 AGCGCCTTATTCGAGAGTCTGCACTGAACCTTCCATATATATGCTGAGAAATAAACCA 1020
Db 930 AAAGACTAATACGTGAATCTTCTGTATCTTTACCATATCATCTACCTGAACCAAAACAA 989
QY 1021 TTCATGATTTCTTCAAAAGTAAACCCCGCCACCTTGCACGGAATGCAATGCACTAT 1080
Db 990 TCCATGATTTTCAAAAGGCTGCAAGGCCCTCTTTGTCAAGGAATGCAATGCACTTAA 1049
QY 1081 TGAAGTCACTTAATATCAGTCAAGCCATCAACAAAGAAATCATAGACACTGCAATACTA 1140
Db 1050 TAAAGTCAACAAATATACCAGCCCTGCACCTGAAGAGAGAAAGAAACCAATG----- 1100
QY 1141 CTGAATGAACAGTGAATCAACATAGTAAAGGTTCTGAGCAGACCAACAGTGCAGAAATG 1200
Db 1101 -----AGGAATATGCTGAGTTC 1121
QY 1201 AAGTGGAACTAATGCACTCCCTGTAGTTTCAAGAGGAACCCAGATCATCTACTGATCAG 1260